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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/662,440

09/16/2003

Hiroichi Ukei

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EXAMINER

ZIRKER, DANIEL R

ART UNIT

PAPER NUMBER

1771

MAIL DATE

DELIVERY MODE

08/29/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/662,440	Applicant(s) UKEI ET AL.	
	Examiner Daniel Zirker	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. The specification is objected to under 35 USC 112, first paragraph, as failing to contain a written description of the invention, and of the manner and process of making and using it, in such full, clear concise and exact terms as to enable any person skilled in the art to make and use the invention, substantially for reasons already of record and as most recently set forth in Paragraph No. 3 of Paper No. 20070405, together with the following additional observations. The Examiner essentially has nothing to add beyond the facts which he has previously presented, as applicants again argue (unconvincingly, in the Examiner's opinion) that very small density differences in extremely well known compositions (HDPE and LDPE) give rise to significantly different properties in the resulting tape supporting substrate, all the while as applicants claim broad ranges of densities and weight percentages of these mixed blends which are used to form the substrates. Applicants' arguments are seen to be little more than a general traversal of the Examiner's position, and as such the Examiner must still hold that the specification remains little more than an invitation to experiment.
3. Claims 1,2 and 5-9 are rejected under 35 USC 112, first paragraph, as being based on a non enabling disclosure.
4. Claims 1,2 and 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishikawa et al, substantially for the reasons set forth in Paragraph No. 5 of Paper No. 20070405, together with the following additional observations. More particularly, applicants' submission of a Rule 132 Declaration from coinventor Ukei is not seen as

possessing a great deal of weight, both for the fact that he is a clearly interested party as well as the fact that the alleged very limited comparison of certain of the data found in the specification sets forth results that are not considered to be unexpected, and also ignores the “Example 2, Comparative Example 3” showing in the reference (beginning at Col 6, line 18) which appears to not use any filler. As regards the alleged unexpected results shown by this single data point the Examiner respectfully submits that significant changes in the elongation at break of the tape (i.e. 0 wt% as opposed to 10 wt% filler in the tape substrate) would clearly be expected by one of ordinary skill when significantly changing the amount of filler present, applicants’ position to the contrary notwithstanding. Note also that Ishikawa et al teaches at Col 4, lines 66-68 that the amount of filler added to the tape will be determined by the “use of the adhesive tape”, with large amounts of filler being present in view of such reasons as reducing cost, increasing the opacity (see, e.g. Col 6, line 45 of Ishikawa et al which Example discussed at that point uses no filler for reasons such as to enhance transparency), and increasing the tearability, which appears to be the major “unexpected property” of the Declaration. In summary, the Declaration appears to clearly fail to rebut the **prima facie** case of record.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is 571-272-1486. The examiner can normally be reached on Monday - Thursday from 8:30 to 6:00. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Daniel Zirker/
Primary Examiner, Art Unit 1771